

REMARKS

Claims 1-13 and 16-19 are pending herein. By this Amendment, independent claim 1 is amended to recite that a golf tee is inserted into the hollow substantially central core. Support for the amendment to claim 1 is found, for example, in paragraph [0023], figures 4 and 5, and independent claim 17.

This amendment was not previously presented in independent claim 1, as Applicant believed that it was fully and clearly understood in view of the present specification and drawings that a golf tee is inserted into the present invention. Further, as the identical subject matter was recited in independent claim 17 of the present invention, inclusion of the language into independent claim 1 should not require additional searching on the part of the Patent Office, and thus should not be burdensome on the Patent Office, as the language was already searched and examined.

Thus, Applicants respectfully request that the Patent Office enter the amendment to independent claim 1.

Accordingly, no new matter is added by this Amendment After Final Rejection.

I. Claim Rejections under 35 USC §112

Applicant respectfully acknowledges and appreciates notice by the Patent Office that the previous rejections under 35 USC §112 have been overcome.

II. Rejection Under 35 USC § 103(a)

A. Claims 1-7 and 9-12

Claims 1-7 and 9-12 were rejected by the Patent Office under 35 U.S.C. § 103(a) for allegedly being obvious over US Design Patent No. D369,845 to Knez (hereinafter “Knez”) in view of US Design Patent No. D181,633 to Fariest (hereinafter “Fariest”). Applicant respectfully traverses the rejection.

Knez fails to teach or suggest the present invention. Instead, Knez shows a golf tee having eight extensions rising up from a circular base. By admission of the Patent Office, Knez fails to teach having one or more support holes in the circular base and three or four bristle packets within the holes as set forth in present claim 1.

Further, Knez teaches and suggests a golf tee design that does not appear to be a golf tee cap as in the present invention. The present invention is a golf tee cap that works in conjunction with a standard golf tee. Knez does not teach or suggest a golf tee cap for a golf tee. Instead, Knez teaches a golf tee.

The Patent Office alleged that the preamble of independent claim 1, stating the present invention as a “golf tee cap,” is not limiting to the present invention being used in conjunction with a golf tee. Applicant respectfully disagrees.

Nowhere in the present invention is the present golf tee cap ever described as being used without a golf tee. The drawings and description clearly show that the present invention is to be used in conjunction with a golf tee. The present invention is not intended by any means to be used without a golf tee being inserted into the hollow substantially central core, and this would be clearly understood to one of ordinary skill in the art based on upon the description, figures, and claims.

Applicant believed that the preamble of independent claim 1, in view of the entire specification and drawings, clearly limited the present invention to being a golf tee cap. “The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.” See *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002) and Manual of Patent Examination Procedure (MPEP) §2111.02. See also, MPEP §2111.02 citing *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) in which “[t]he determination of whether preamble

recitations are structural limitations can be resolved only on review of the entirety of the application ‘to gain an understanding of what the inventors actually invented and intended to encompass by the claim.’”

Applicant feels that the preamble of independent claim 1 was structurally limiting as a “golf tee cap” as opposed to a “golf tee.” Applicant further respectfully asserts that the structural limitation to be distinguishing over the prior art.

Nonetheless, in order to place the application in better condition for allowance, by this Amendment, independent claim 1 of the present invention is amended to more clearly recite that a golf tee is inserted into the present invention.

The Patent Office alleges that Knez “could be termed a golf tee cap that is merely placed on the ground.” Applicants respectfully disagree.

Nowhere in Knez is the invention referred to or presented as anything other than a “golf tee.” This is further supported by Knez never showing the golf tee as being used in conjunction with a golf tee as in the present invention. The Knez golf tee is only shown as a single-piece golf tee. There is no motivation, based on the teachings of Knez, for one of ordinary skill in the art to develop the present golf tee cap.

Fariest fails to overcome the deficiencies of Knez.

Fariest was relied on by the Patent Office as allegedly teaching a golf tee design including a base member and a plurality of bristle packets for support of a golf ball.

The present invention is a golf tee cap that fits a standard golf tee. Like Knez, Fariest is a golf tee. The Fariest golf tee design limits the play options for a player. That is, for example, the Fariest golf tee requires trimming the groups of bristles in certain situations in order to be able to properly hit the ball. As the present invention is a golf tee cap, it allows for greater variation in height and allows for better dissipation of energy when struck by a golf club.

The present invention also has three or four bristle packets extending upwardly from the base member. Fariest's design has eight bristle packets extending upward from a base member. Nowhere in Fariest's design is it taught or suggested that there is any advantage in limiting the number of bristle packets to three or four as in the present invention.

Limiting the number of bristle packets to three or four as in the present invention dramatically decreases the coefficient of friction between the ball and the bristle packets. This is because there are fewer contacts between the ball and bristle packets as a whole.

In addition, having three or four bristle packets allows for a golf ball to be struck by a golf club and fly away from the golf tee cap and associated golf tee with a minimum obstruction created by any bristle packets in front of the ball.

That is, as a golf ball is struck by a golf club, it compresses slightly as it moves forward in the direction of the swing of the golf club. If bristle packets are in front of the golf ball as it is struck, compresses, and move forward, these bristle packets can hinder the forward movement of the ball. Having three or four bristle packets allows for the minimum number of bristle packets upon which to rest a ball and therefore also the least possible obstructions to the forward movement of a struck golf ball.

This is further supported in the June, 2005 issue of *Golf Digest*, which independently compared a number of golf tees to the present golf tee cap. One of the golf tees which was compared to the present golf tee cap was the Fariest design. In an independent and automated evaluation, the present golf tee cap was shown to consistently allow further movement of at least several yards of the struck golf ball than a golf ball hit off the Fariest design. In the game of golf, several yards difference may be a tremendous advantage. The smaller number of bristle packets in the present invention, in contrast to the Fariest design, greatly reduced the amount of friction between the golf ball and the golf tee cap (in the present invention) as compared to the amount of friction between the golf ball and the golf

tee of the Fariest design. This reduced amount of friction in the present invention allowed more energy to be transferred to the golf ball's forward movement and therefore, go further.

In addition, like Knez, Fariest is a golf tee, not a golf tee cap as in the present invention.

Thus, for the foregoing reasons, Applicant submits that Knez and Fariest, whether taken singly or in combination, fail to teach or suggest the present invention.

Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 8, 13 and 16-19

Claims 8, 13 and 16-19 were rejected by the Patent Office under 35 U.S.C. § 103(a) for allegedly being obvious over Knez in view of Fariest and US Patent No. 1,670,123 to Ranseen (hereinafter "Ranseen"). Applicant respectfully traverses the rejection.

Claims 8, 13, and 16 are dependent upon independent claim 1. Claims 18 and 19 are dependent upon independent claim 17.

As set forth above with regard to independent claim 1, and therefore also to independent claim 17 which includes the same limitations as claim 1, Knez fails to teach or suggest the present independent claims. In particular, Knez fails to teach or suggest the present golf tee cap having support holes in the circular base and three or four bristle packets within the support holes.

Fariest fails to overcome the deficiencies of Knez. As set forth above, Fariest fails to teach or suggest the present golf tee cap having support holes in the circular base and three or four bristle packets within the support holes.

Ranseen fails to overcome the deficiencies of Knez and/or Fariest. Ranseen was relied upon as allegedly teaching a golf tee collar connected to a flexible cord and weight for anchoring the golf tee when struck by a golf club.

However, Ranseen fails to describe a golf tee cap having support holes in the circular base and three or four bristle packets within the holes as set forth in the present independent claims 1 and 17. In fact, a golf ball placed on a golf tee having the Ranseen golf tee collar would still be placed on the top portion of a standard golf tee. As such, the ball would have to overcome at least the same frictional forces, if not more, when struck with a golf club as compared to a standard golf tee, and therefore much more frictional force than when the present golf tee cap is used.

The Patent Office alleges that Ranseen teaches that it is well known in the art of golf tees to form a golf tee cap for the tee for supporting the golf ball. Applicant respectfully disagrees.

The collar taught in Ranseen is to be attached to a flexible cord to limit the distance to which a golf tee may fly if struck by a golf club.

In the instances in which the collar of Ranseen is not tethered (see Figure 5), the collar is described as forming “a more substantial seat for the golf ball. This obviates the necessity of using larger stock for turning out tees having larger ball seats ...” See column 2, lines 17-20.

The collar of Ranseen actually teaches away from the present golf tee cap. The present golf tee cap is designed to significantly reduce the amount of friction of a golf ball being struck off a golf tee or golf tee cap. In Ranseen, the seat in which the ball rests is larger and “more substantial.” This logically can only mean that the collar of Ranseen is increasing the amount of friction the struck ball must overcome.

Nowhere is there any motivation given to combine the teachings of Knez with Ranseen. Ranseen teaches a golf tee having a collar that increases the amount of friction on a golf ball. Knez teaches a golf tee that is placed on the ground without the use of a golf tee as

in the present invention. Further, nowhere does Knez suggest its golf tee design to be used as a golf tee cap as in the present invention or a golf tee “collar” in the case of Ranseen.

Even should it be asserted that Ranseen teaches “golf tee caps,” Ranseen teaches golf tee caps that increase the amount of friction on a golf ball. One of ordinary skill in the art of golf equipment is trying to substantially decrease the amount of friction on a golf ball. As such, one of ordinary skill in the art would not be motivated to use golf tee collars as taught in Ranseen to reduce friction on the golf ball.

Thus, for the foregoing reasons, Applicant submits that Knez, Fariest, and Ranseen, whether taken singly or in combination, fail to teach or suggest the present invention.

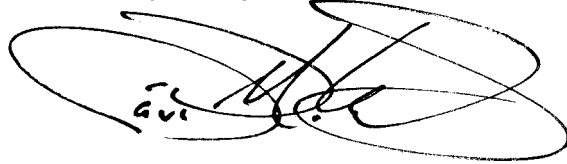
Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing amendment and remarks, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-13 and 16-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance; the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Lafkas', enclosed within a large, loopy oval flourish.

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DML/hs

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